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REMARKS

In this submission, the above listing of the claims replaces all prior versions, and listings, of claims in the application. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Claim Status

Claims 1-19 stand provisionally rejected for double patenting; and

Claims 1-19 stand rejected under 35 USC § 103.

Claim Amendments

In this response, the claims have been amended in a manner which improves the clarity with which the claimed subject matter is set forth. For example, claim 1 has been amended to call for:

A printing method, comprising the steps of:  
receiving print stream data at a printer;  
detecting a network address in the received print stream data;  
if a network address is detected, then displaying or  
    sending a message notifying a user entity of the  
    network address detection and requesting  
    authorization from the user entity to access the  
    network address;  
if authorization to access is received from the user entity,  
    sending on the Internet or other network an access  
    request for a document to the network address;  
retrieving the document from the network address;  
merging the document from the network address into the  
    print stream data to form a modified document; and  
printing the modified document.

As will be appreciated, one of the claimed features is that the document which is retrieved from the network by the printer, is merged into the print stream which is

received at the printer in a manner which forms a modified document – which is then printed out by the printer. It is submitted that this feature is neither found in nor suggested by the art of record. In other words, the present invention is directed to what can be considered to as a “smart” printer which is capable of performing a number of different operations within its own right.

#### Double Patenting

It is respectfully submitted that the Applicant is willing to consider the filing of a terminal disclaimer, however, wishes to wait until either this application or one of the below listed copending applications issues, thus establishing which applications will be terminally disclosed with respect to which. In the interim, the double patenting rejection is provisionally traversed for at least the reason that it is not yet determined what the exact scope of the claims of each application will be at the time of their respective allowance. The double patenting rejection is also traversed in that the claims of this and the other three applications have been amended in a manner which is deemed to overcome the rejection.

- |    |            |               |            |                    |
|----|------------|---------------|------------|--------------------|
| 1) | 10012443-1 | (084061-0165) | 09/925,649 | Examiner Wallerson |
| 2) | 10012446-1 | (084061-0166) | 09/925,650 | Examiner Wallerson |
| 3) | 10012445-1 | (084061-0167) | 09/925,651 | Examiner Singh     |

#### IDS

An IDS which lists the above disclosed applications along with the art cited therein, is submitted with this response.

#### Rejections under 35 USC § 103

- 1) The rejection of claims 1-10, 13-14 and 18-19 under 35 USC § 103(a) as being unpatentable over Tabata et al. in view of Russell et al., is respectfully traversed.

In order to establish a prima facie case of obviousness, it is necessary to show that the hypothetical person of ordinary skill would, without any knowledge of the claimed subject matter and without any inventive activity, be able to arrive at the claimed subject matter given the guidance of the cited references when each is fully considered as statutorily required.

It is submitted that the rejection is improper for at least the following reasons.

- i) Tabata et al.: Printer and Scanner are disclosed as different devices

The Tabata et al. reference, at column 23, lines 10-12, discloses that a copying machine 470 comprises a scanner unit 470A as a “correlated information identifying unit” and a printer 470B as an “output unit” and that the two units are ***integrated*** into one device (viz., ***integrated*** into the copying machine 470).

Indeed, this reference continually discloses throughout the document that scanners and printers are functionally different devices. It is irrefutable that the hypothetical person of ordinary skill would understand that when a printer and a scanner are integrated, the “integration” merely refêrs to enclosing the two different devices in close proximity in the same housing and not arrive at the notion that simply because the scanner and the printer are integrated into the same housing that the printer can be expected to perform some or all of the functions of the scanner and vice versa. This is simply irrational and cannot form a basis for a *prima facie* case of obviousness.

The position that the Applicant has “conveniently disregarded” Tabata’s disclosure of “integration” is noted. This is traversed. The rejection is made under § 103 which requires the disclosure to be taken as a whole by a hypothetical person of ordinary skill. For example, Tabata can be relied upon to disclose:

When the correlated information file 450 is read by the **scanner unit 430** and is outputted by the **printer 460**, any handy printer 460 or any printer 460 appropriate for a certain purpose connected to the network Net can be selected for use, so that convenience in actual use is improved.

Further, when any copying machine 470 with a scanner unit (correlated information identifying unit) 470A and a printer (an output unit) 470B **integrated into one device is used, the system on the whole can be minimized, and reading as well as outputting can be executed by**

**one device at a place**, which allows operability to be improved.

FIG. 22 shows a system diagram of a document information management system according to Embodiment 5, and the system comprises a file device 410 as a file unit with a hypertext and information correlated, through link structure of the hypertext, to particular words, sentences, symbols, or graphics on the hypertext stored therein as a correlated information file; a medium form 420 with at least one described information comprising any of words, sentences, symbols, and graphics, linkage information for linking the described information to the correlated information file in the file device 410, and selection information for selecting particular described information among the described information recorded thereon; **a scanner 510 as an image data reader for reading image data from the medium form 420**; a file server 520 as a correlated information file identifying/retrieving unit for receiving image data from the **scanner 510**, identifying an address of the selected correlated information file according to the selection information as well as linkage information in the image data, and retrieving an appropriate correlated information file from the file device 410; **a printer 460 as an output unit for printing the correlated information file retrieved by the file server 520** on recording paper and outputting the paper as a correlated information file 450; and a **copying machine 530 with a scanner 530A as an image data reader and a printer 530B as an output unit integrated into one device**.

In addition, any existing scanner can be used as a **scanner 510**, any existing printer can be used as a

**printer 460**, and further any existing copying machine can be used as a copying machine 530. (Emphasis added)

Just how this disclosure suggests to the hypothetical person of ordinary skill that claimed requirement that data can be received at a printer (using a device actually disclosed as being a “scanner” in this document) and that the rest of the steps recited in the independent claims (for example) can be performed using this data, is simply beyond ken.

The copying machine 530 (viz., the integrated device) has a scanner 530A and a printer 530B. Note the disclosure: **a copying machine 530 with a scanner 530A as an image data reader and a printer 530B as an output unit integrated into one device**. Why, if the position taken in this rejection is correct does the disclosure assign separate numbers to the scanner and the printer arrangements even when they are “integrated”, and what is the rational justification for ignoring this disclosure?

The claims as amended require the printer to receive a print stream. Clearly, it would not be expected by the hypothetical person of ordinary skill that a scanner would receive a “print stream.”

ii) Tabata et al. : Printer does not receive print stream data containing address data

It is submitted that the disclosure of column 23, lines 56-63, which is relied upon in this rejection neither discloses nor suggests the printer receiving any data. In fact, this section indicates that it is the scanner unit that reads the medium and reads a code area 206 which is on the medium as raster information. More specifically, column 23, lines 56-63, discloses:

Then, the medium form 420 with the mark(s) 51 added thereto is read by the scanner unit (correlated information identifying unit) 430 or 470A (S2101). In this case, each of the scanner units 430, 470A reads a code area 206 from the medium form 420 as raster information and also reads a text section with the mark(s) 51 added thereto. With

those operations, linkage information and selection information are supposed to be read.

It is therefore clear that if data, which contains an address, is “received” by device then it would be understood by the hypothetical person of ordinary skill as being “received” by the scanner and not the printer. This disclosure teaches away from the claimed subject matter.

Thus, in a nutshell, the claims call for the printer to receive a printer data stream which can include certain information such as network address. Tabata et al. teaches the use a scanner which is associated with a printer to receive data inputs, and therefore leads the thinking of hypothetical person of ordinary skill away from using the printer for this purpose. In fact, the disclosure of the Tabata et al. is such as to lead the thinking of the hypothetical person of ordinary skill in the direction that the printer is to be used for just printing and no more.

- iii) The claimed request for authorization is triggered by network address in data received at the printer – not the scanner

The independent claims of this application call for an operation wherein if a network address is detected, then a message is either displayed or sent notifying of the network address detection, which requests “authorization” to access the network address.

The rejection acknowledges that Tabata et al. does not “clearly” disclose requesting “authorization” to access the network address and turns to Russell et al. to overcome this admitted shortcoming in teachings.

The rejection takes the position that using a password in Tabata et al., and sending this password to a remote administration location would have been obvious at the time of invention in that it would have improved the securing of the system. However, when one considers the concept on which Tabata et al. is based, it is clear that the only way into the system is through a scanner which scans a medium, sends the information derived from the scanning to a file server which is triggered to send the appropriate print instructions to the printer. If there is to be a password it would have to

be incorporated into the medium 210 and the scanner 60 (see Fig. 1) adapted to refuse to scan/transmit if the password was not provided. In this connection, the teachings of Russell may be consulted. However, the use of the teachings of Russell et al. would mean that the printer would never be able to respond to this type of password and it would always have to be the scanner which performs this function. The claimed invention, therefore could not be arrived at via the transfer of teachings.

- 2) The rejection of claims 11 and 12 under 35 USC § 103(a) as being unpatentable over Tabata et al. in view of Russell et al and further in view of Wolff, is respectfully traversed.

It is submitted that the teachings of Wolff would not overcome the tendency for the teachings of Tabata et al. and Russell et al. to teach away from the claimed subject matter. Indeed Wolff has been cited only to overcome the admitted shortcoming that Tabata et al. does not disclose/suggest the receipt of data via e-mail.

It is submitted that the system of Tabata et al. does not lend itself readily to internet access and, as noted above, is basically dedicated to scanning data off sheets of medium such as paper, and feeding the data thus obtained to a server for further action such as printing. As noted above, the teachings of Russell et al. are such as reinforce this tendency. Hence, the citation of Wolff merely adds confusion as to how an e-mail connection could be introduced into the arrangement disclosed in Tabata et al. without inducing a departure from the basic intentions of Tabata et al.

This rejection is deemed untenable, and is traversed for at least this reason.

- 3) The rejection of claims 15-17 under 35 USC § 103(a) as being unpatentable over Tabata et al. in view of Russell et al and further in view of Wolff, is respectfully traversed.

In this rejection, Wolff has been cited solely to overcome the admitted shortcoming that Tabata et al. does not disclose printing one document in another and identifying the contents of the documents. However, Wolff actually fails to suggest printing one document in another and can be relied upon only to suggest that different documents can be obtained and an image of each of the documents be generated –

see the steps disclosed in Fig. 4. There is no disclosure of merging two different documents and therefore no disclosure of printing one document in another in the manner purported.

Conclusion

It is submitted that the claims are allowable over the art for at least the reasons advanced above. Favorable reconsideration and allowance of the claimed subject matter is courteously solicited.

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